

Remarks
In the Specification

None.

5 Rejection Under 35 USC 112

Claim 10 stands rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the inventive subject matter as the limitation “the linear rate creating an interior protrusion is between 10 and 20 degrees” is indefinite because it is unclear to which point of reference the rate is measure.

10 With respect to Claim 10 Applicant points Examiner to Fig. 4 that illustrates the interior protrusion being created with a 15 degree angle with respect to the interior wall’s (306) location as it extends from the opening of the lid (401) to the radial transition (403). Applicant has amended the language of Claim 10 to specifically reference the points at which the rate is measure. Withdrawal of the rejection is respectfully requested.

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Improper Final Office Action Issued

M.P.E.P. Section 706.07(a), states, in part “second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is
20 neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement”. In the present case, Applicant’s Amendments to Claim 10 were limited to merely amending the language of the claim that described the radial protrusion as required by the Examiner under the previous rejection under 35 USC 112, second paragraph as being indefinite for not clearly defining the rate.

Here Examiner has replace the original basis for rejection from the first office action, that being Claim 10 is unpatentable over McLaren, et al. US 4,407,426 in view of Hopkins US 3,966,08, with Claim 10's current rejection basis of that of anticipation by '268, creating a new 102 rejection. Additionally, Claim 10 previously unpatentable over McLaren, et al. US 4,407,426 in view of Hopkins US 3,966,082 under 35 USC 103 has been replaced by rejections under 35 USC 103 based on Johnson, et al. US 3,892,351 in view of Smith US 4,222,974, and in view of Shapiro US 1,093,735; and Smith US 4,222,974 in view of Johnson US 3,892,351 and in view of Shapiro US 1,093,735.

Examiner concedes in paragraph 9 that Applicant's previous arguments are now moot in view of the new grounds of rejection with respect to claims 1-14. Applicant respectfully contends that the new grounds of rejection is now in accordance with the rules for the issuance of a final office action and request the withdrawal of the final office action and consideration of the following amendments.

15 ***Rejections Under 35 USC 102***

Claim 10 stands rejected under 35 USC Section 102(b) as being anticipated by Kuzma, et al. US Patent No. 5,769,268 hereafter referred to as '168. With respect to claim 10, Examiner cites '168, stating that is discloses a base lid comprising:

- a. a body having a bottom wall and a side wall;
- 20 b. said side wall having an interior surface and exterior surface, the interior surface of the wall defining the opening;
- c. said body consisting of a tab positioned on the side of the body;
- d. the defining opening created by the body, side wall, and bottom defining a round opening.;
- 25 e. an interior wall with recessed and protruding areas;
- f. said interior wall thickness increases at a linear slope rate from the opening toward the bottom of the base lid and defining a protrusion at a small radial arc, said interior wall thickness then decreases at a linear rate defining an angular slope toward the

exterior wall, and then remains at a constant wall thickness until the base wall is reached;
g. said linear rate creating an interior protrusion is between 10 degrees and 20 degrees.

5 With respect to claims 1 and 4 anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not enough that the prior art reference discloses all the claimed elements in isolation, rather anticipation requires disclosure as arranged in the claim. See. *W.L. Gore & Associates v. Garlock, Inc.* Claim 10 has been amended to include the language “in combination” explicitly making the claims a
10 specific combination of the elements claimed therein.

In Examiner’s rejection, a first based on ‘268, not a single element other than the interior protrusion (element 14 of ‘268) is listed as being taught by ‘268.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not enough that the prior art reference discloses all the
15 claimed elements in isolation, rather anticipation requires disclosure as arranged in the claim. See. *W.L. Gore & Associates v. Garlock, Inc.* By Examiner’s own words, and lack thereof, it is clear that ‘268 does not teach the specific slop rate of the interior protrusion. Examiner has made no citation to such a teaching in ‘268 and ever further, in under Examiner’s Claim Rejections –
35 USC Section 102, Examiner writes “being inclined, the bead inherently creates a slope rate of
20 between 10 and 20 degrees” clearly an indication the Examiner can not support the required disclosure under 35 USC 102 in ‘268. Also, the slope of ‘268 may not inherently create a slop of between 10 and 20 degrees, it could just as easily be between 1 and 9 degrees or 21 and 30 degrees. That which may be inherent is not necessarily known. See *In re Spormann*, 363 F.2d 444, 150 USPQ 449 (C.C.P.A. 1966).

Further anticipation will not be found when the prior art is lacking or missing a specific feature or structure of the claimed invention. Here, as previously discussed, ‘268 does not disclose the specific slop rate of the interior protrusion between 10 and 20 degrees. Withdrawal of this rejection is respectfully requested.

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Rejections Under 35 USC 103

Claim 10 stands rejected under 35 USC Section 103(a) as being unpatentable over on Johnson, et al. US 3,892,351 in view of Smith US 4,222,974, and in view of Shapiro US 1,093,735; and Smith US 4,222,974 in view of Johnson US 3,892,351 and in view of Shapiro US 1,093,735.

With respect to Claim 10, Court decisions have establish that a prima face case of obviousness is established when an examiner provides:

1. one or more references
2. that were available to the inventor and
3. that teach
4. a suggestion to combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

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Accordingly, an Applicant who is able to prove that the Examiner has failed to establish any one of these elements will prevent the prima facia case of obviousness form being established.

In the Examiner’s first set of § 103 rejection based on Johnson, et al. US 3,892,351 in view of Smith US 4,222,974, and in view of Shapiro US 1,093,735, the Examiner combines ‘351 and ‘974. Alleging that ‘426 and ‘974 teaches all element of the present invention found in Claim 10 except a tab on the side of the body, Applicant respectfully disagrees.

Applicant concedes the elements a-e are taught by '426 and '974 as cited by examiner in the office action, but respectfully disagrees that elements f and g in their entirety are taught nor suggested by '426 and '974. Examiner concedes that the slope rate is not taught but is "inherent" and that a sharp edged transition is taught by '974 rather than the radial transition of the present invention.

Examiner writes "being inclined, the bead inherently creates a slope rate of between 10 and 20 degrees" clearly an indication the Examiner can not support the required disclosure under 35 USC 102 in '268. Also, the slope of '268 may not inherently create a slope of between 10 and 20 degrees, it could just as easily be between 1 and 9 degrees or 21 and 30 degrees. That which may be inherent is not necessarily known. See *In re Spormann*, 363 F.2d 444, 150 USPQ 449 (C.C.P.A. 1966).

Spormann teaches that arguments based on inherent properties can *not* stand when there is no supporting teaching in the prior art. Inherency and obviousness are distinct concepts. Thus, an Examiner's obviousness rejection is improper if and when the Examiner indicates that specific features of the application, although not shown in the prior art, are inherent. Here Examiner states specifically that a slope value is not taught or considered, but simply states it is inherent. Examiner's basis fails under *Spormann* and withdrawal of the rejection is respectfully requested.

With respect to the sharp edge taught by '974, Applicant agrees with examiner that typically a change in form or shape is generally not recognized as patentable under *In re Dailey et al.* unless there is an unexpected result, utility, or other valid purpose for the change. Here Examiner contends that there is no unexpected result and that the shape seems arbitrary "considering it does not make contact with the container bead."

With respect to the radial shape of the present invention, it was determined that a radial edge would provide a better grip or securing means to containers with profiled transitions between side walls and bottoms. The main purpose of the present invention is to cover the bottom surface of untreated metal containers in bathroom environment so that rust stains are not left on counter and shower surfaces. The radial design of the present invention provides for a better and more securing fit of the lid to the container while also providing a watertight seal keeping water and moisture out. The shape is not arbitrary by any means and Fig. 4 of the application clearly illustrates how the radial protrusion matches that of a typical container profile and the contact area between them.

No suggestion to combine or modify the references. There is no visual or written citation or suggestion in either '351 or '974 that suggest modifying the inner wall shape to extend from the arc to the sidewall at a regular slop angle before continuing to the exterior wall at a predetermined thickness, instead only a radiused transition and sharp edge are taught by the cited prior art.

The protrusion taught by '426 fails, with its sharp "shoulder" fails in use in several ways. First, a sharp shoulder or protrusion makes lid attachment and removal difficult by requiring more force to remove a rolled edge contain from the lid. A radial arc reduces the force necessary for removal. Secondly, a sharp edge as taught by '426 is often catches on the edge of a rolled edge container and causes the lid to be broken, torn, or pierced during removal. Withdrawal of the rejection is respectfully requested.

Applicant concedes that it would be obvious to one of ordinary skill in the art to add tabs as taught by Shapiro '735 to a lid for aiding a user in the application or removal from a container.

In the Examiner's second set of § 103 rejection based on Smith US 4,222,974 in view of Johnson US 3,892,351 and in view of Shapiro US 1,093,735, the Examiner combines
5 '974 and '351. Alleging that '974 and '351 teaches all elements of the present invention found in Claim 10 except a tab on the side of the body, Applicant respectfully disagrees.

Applicant concedes the elements a-e are taught by '974 and '351 as cited by examiner in the office action, but respectfully disagrees that elements f and g in their entirety are taught nor suggested by '974 and '351. Examiner concedes that '974 fails to teach a radial arc and that
10 '351 fails to teach the bead extending from the arc to the sidewall at a regular slope angle before continuing to the exterior wall at a predetermined thickness, instead teaching a radiused transition.

Examiner contends that "one having ordinary skill in the art would recognize a small round arc affords a smooth snap as that bead slips over a container," but fails to provide one such
15 example or address the lack of such a teaching in the prior art. Common Knowledge and Common Sense are not sufficient to supply motivation for modifications. The factual inquiry to modify must be based on objective evidence of records. *Ex parte Humphreys* holds that when an Examiner does not provide specific reasons to support the obviousness rejection, they have failed to establish the prima facie case of obviousness. Here Examiner states the specific reason to
20 support the modification is that a small round arc affords a smooth snap as that bead slips over a container, but provides no teaching on whether a smooth snap is or was desired.

Examiner also fails in this second attempt to combine '974 and '351 in some combination as a basis of rejection to address element g, that "said linear rate creating an interior protrusion is between 10 degrees and 20 degrees."

A prima face case of obviousness is established when an examiner provides:

1. one or more references,
2. that were available to the inventor and
3. that teach,
4. a suggestion to combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Accordingly, an applicant who is able to prove that the Examiner has failed to establish any one of these elements will prevent the prima facie case of obviousness from being established. Here Examiner has ignored element g, which requires that "said linear rate creating an interior protrusion is between 10 degrees and 20 degrees." Examiner properly addresses this limitation in his first 103 rejection (paragraph 6), but fails to explain how it is taught in the second 103 rejection (paragraph 7).

With respect to the sharp edge taught by '974, Applicant agrees with examiner that typically a change in form or shape is generally not recognized as patentable under *In re Dailey et al.* unless there is an unexpected result, utility, or other valid purpose for the change. Here Examiner contends that there is no unexpected result and that the shape seems arbitrary "considering it does not make contact with the container bead."

With respect to the radial shape of the present invention, it was determined that a radial edge would provide a better grip or securing means to containers with profiled transitions between side walls and bottoms. The main purpose of the present invention is to cover the bottom surface of untreated metal containers in bathroom environment so that rust stains are not

left on counter and shower surfaces. The radial design of the present invention provides for a better and more securing fit of the lid to the container while also providing a watertight seal keeping water and moisture out. The shape is not arbitrary by any means and Fig. 4 of the application clearly illustrates how the radial protrusion matches that of a typical container profile and the contact area between them.

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The protrusion taught by '426 fails, with its sharp "shoulder" fails in use in several ways. First, a sharp shoulder or protrusion makes lid attachment and removal difficult by requiring more force to remove a rolled edge contain from the lid. A radial arc reduces the force necessary for removal. Secondly, a sharp edge as taught by '426 is often catches on the edge of a rolled edge container and causes the lid to be broken, torn, or pierced during removal. Withdrawal of the rejection is respectfully requested.

Applicant concedes that it would obvious to one of ordinary skill in the art to add tabs as taught by Shapiro '735 to a lid for aiding a user in the application or removal form a container.

With respect to Claims 15 and 16 Applicant has cancelled Claims 15 and 16 making traverse of the examiner's rejections to those specific claims moot.

Conclusion

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and that action is earnestly solicited.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely.

Respectfully submitted,



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